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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/369,231 08/05/99 WALTER

J MP/143

EXAMINER

IM52/0411

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VOL. H

ART UNIT

PAPER NUMBER

1771

DATE MAILED:

04/11/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

09/369,231

Applicant(s)

WALTER, JAMES TODD

Examiner

Hai Vo

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-7, 9-11 drawn to a material, classified in class 428, subclass 141.
 - II. Claim 8, drawn to a process for modifying a material surface, classified in class 264, subclass 413.
2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, altering the fibril lengths and removing the nodes can be done by a plasma treatment.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with David Johns on 03/30/01 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-7, 9-11. Affirmation of this election must be made by applicant in replying to this Office action. Claim 8 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-7, 9-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "a surface" as recited within claim 1 renders the claim indefinite. Does the applicant mean the surface of PTFE or the surface of the material? Similarly, the term "a texture pattern" within claim 2 is confusing. Does the applicant mean the texture pattern of PTFE or the texture pattern of the material?

Claim Objections

6. Claim 9 is objected to because it is dependent on non-elected claim.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zukowski (US 5,462,781) in view of Mano, (US 4,713,070). Zukowski teaches an expanded PTFE material having a microstructure of nodes interconnected by fibrils. The modification process taught by Zukowski creates a surface comprised of freestanding

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node portions having open valleys disposed between them. See abstract. Since the applicant recites that the freestanding nodes of Zukowski are in actually easily bent or deflected due the lack of interconnecting fibrils or other support structure (page 5, lines 26-27), the freestanding nodes would be expectedly twisted into any state of deformity under the condition. Zukowski does not specially disclose the surface having a number of node clusters. However, Mano discloses in analogous art that a PTFE material having a microstructure of nodes interconnected by fibrils, ridges, and valleys. The ridges are comprised of cluster nodes. See Applicant's recitation on page 6, 21-22. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the ridges of clustered nodes in the PTFE surface of Zukowski, motivated by the desire to obtain a porous structure of PTFE having improved strength.

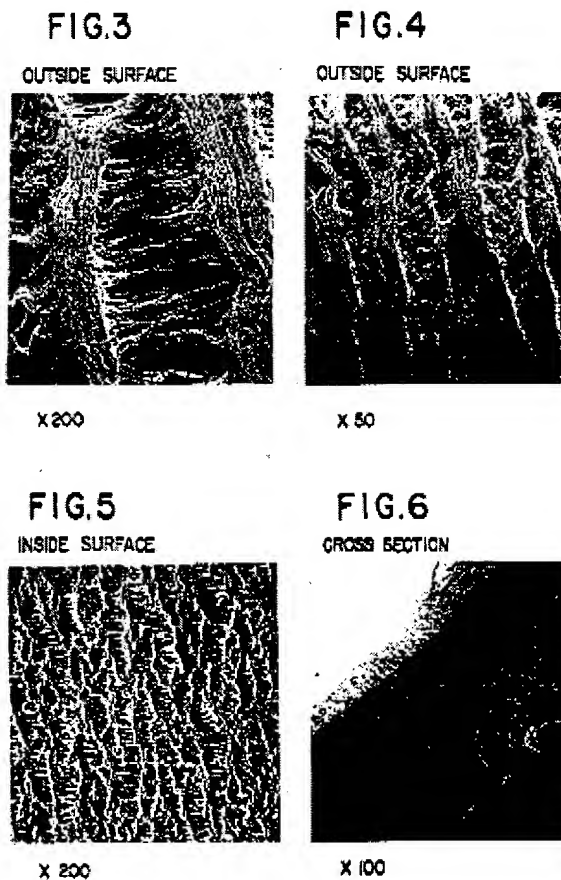
Figure 2A of Zukowski broadly shows the gnarled node having all the features as recited in claims 3, 4. In addition, these features can be seen in present figure 1B, and specification on page 5, lines 24-27. The examiner takes the position that the gnarled node having a longitudinal axis and angular deflection points along this axis would not involve any inventive concept because as the freestanding node twisted in any state of deformity, it should have a longitudinal axis and angular deflection points along this axis as recited by the applicant. For this reason, having these features as claimed in the gnarled node of Zukowski would have been obvious to one having ordinary skill in the art at the time the invention was made.

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With regard to claim 5, the figures 3 and 4 of Mano show that the multiple ridges are parallel to each other.

With regard to claims 6 and 7, Mano discloses a porous PTFE having two opposing surfaces, and two opposing surfaces having multiple ridges and valleys. See abstract

Figures 3-6
of Mano, US
4,713,070



and figures 3-6.

With regard to claim 9, it's the examiner's position that the article of Mano as modified by Zukowski is identical to or only slightly different that the claimed article prepared by the method of the claim, because both articles use the same materials (PTFE), having

structural similarity (node-fibril microstructure). Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product suggested in the prior art. *In re Marosi*, 218 USPQ 289,291 (Fed. Cir. 983). It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with Mano/Zukowski product.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 10 and 11 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Mano (US 4,713,070).

Figures 1 and 2 of Mano disclose all limitations as recited in claims 10 and 11.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-4426. The examiner can normally be reached on Monday to Friday, 8:30 to 5:00 (EAST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on (703) 308-1261. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3599 for regular communications and (703) 305-7718 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3601.

HV
April 6, 2001


BLAINE COPENHEAVER
PRIMARY EXAMINER